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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/659,093 | 09/09/2003 | John G. Gilliland | 0112300-1682 | 4315 |

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BELL, BOYD & LLOYD LLP
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| EXAMINER | |
|---|---|
| THOMASSON, MEAGAN J | |
| ART UNIT | PAPER NUMBER |
| 3714 | |

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
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| 3 MONTHS | 03/13/2007 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/659,093 | GILLILAND ET AL. | |
| | Examiner | Art Unit | |
| | Meagan Thomasson | 3714 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *09 August 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-51* is/are pending in the application.

4a) Of the above claim(s) *13-23 and 25-36* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-12,24 and 37-51* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *09 September 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *8/9/06*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 9, 2006 has been entered.

### *Response to Amendment*

The examiner acknowledges that claims 12-23 and 25-36 have been canceled.

### *Allowable Subject Matter*

The indicated allowability of claims 1-12,24 and 37-51 is withdrawn in view of the newly discovered reference(s) to Thomas et al., Brossard and Walker et al. Rejections based on the newly cited reference(s) follow.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 37 recites the limitation "the symbols" in line 5. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

**Claims 1-9,24, 37, 39-45 and 47-51 are rejected under 35 U.S.C. 102(e) as being anticipated by Thomas et al. (US 6,190,255 B1).**

Regarding claims 1 and 47-51, wherein the limitations of the claim are drawn to a gaming device comprising:

a display device,

a primary game operable upon a wager by a player,

a plurality of different game display interfaces operable to be displayed by the display device to represent said primary game to the player, wherein each interface includes a plurality of different symbols, wherein the symbols in each interface perform an identical function in the primary game with respect to corresponding symbols in the other interfaces, and wherein a plurality of the corresponding symbols in the interfaces are visually different from one another, and

an event that causes the display device to switch from displaying on of the interfaces for said primary game to another one of the interfaces for said primary game.

As defined by the claim limitation, a "display interface" is merely a scene presented to the player comprising a plurality of different symbols. From this broad definition, it can be said that the symbol matrix displayed to a player upon activation of the reel spin input device may constitute the "display interface". In other words, every time a player places a wager and activates the reel spinning mechanism, the symbols displayed upon the reels after the reels stop spinning may be considered a "display interface". Further, if a symbol's "function" is defined to be the amount awarded for an occurrence of said symbol, Fig. 3 shows two corresponding symbols, a cherry and a strawberry, whose function is identical, i.e. a player is awarded two credits for the occurrence of said symbol in the display interface, and wherein the corresponding symbols are visually different from one another. The event that causes the display device to switch from one interface to another may be defined as the reel spin activation mechanism, wherein every time the reels spin a new display interface is displayed to the player.

Regarding claim 2, wherein the event is the player's selection of an input device that enables the player to select to switch from one of the interfaces to another one of the interfaces, selecting the reel spin activation mechanism constitutes an input device of either a pulling a lever or pushing a button (col. 4, lines 3-5).

Regarding claims 4,5,7,40,41 and 43, at least two of the display interfaces may include at least one visually identical symbol, as a symbol will likely re-appear in the display interface in subsequent spins.

Regarding claim 6,8,42 and 44, wherein the corresponding symbols are provided in the same frequency, Fig. 4 discloses a table wherein a pay combination containing a strawberry has a 0.049383 probability of occurrence, as well a pay combination containing a cherry has a 0.049383 probably of occurrence, thus the corresponding cherry and strawberry symbols have the same frequency.

Regarding claims 9 and 45, wherein the corresponding symbols have different but related indicia, the strawberry and cherry symbols are visually different but related in that they are both fruit symbols.

Regarding claim 37, Thomas discloses the use of a menu operable to be displayed to the player that displays the symbols of the interfaces to the player. The paytable shown in Fig. 3 is essentially a menu that presents all symbols of the interfaces to the player.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims 10,24 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas et al. (US 6,190,255) in view of what is known to one of ordinary skill in the art.**

Regarding claims 10 and 46, wherein the corresponding symbols have different but unrelated indicia, the selection of a strawberry and cherry as the indicia having identical payouts is arbitrary. The designer may have chosen the strawberry and the bell to both have a payout of 2 credits, which are two different and unrelated symbols. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to choose corresponding symbols have different but unrelated indicia.

Regarding claim 24, wherein at least two of the interfaces are characterized by having payouts with different volatilities, payouts yielding different expected values, payouts with different eligibility requirements, and payouts with different triggering

mechanisms, all of symbol display matrices, i.e. display interfaces, may contain any of these features. Such features in slot machine games are well known in the art and do not render the invention new, novel or unobvious. For instance, to be eligible for a payout resulting from a symbol combination on payline 24, two credits must be wagered (col. 4, lines 22-33) and thus various eligibility requirements are implemented.

**Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas et al. (US 6,190,255) in view of Walker et al. (US 6,068,552).**

Regarding claims 11 and 12, wherein each of the interfaces includes indicia consistent with a different game theme, and further that each theme is selected from the group consisting of: a movie theme, a television show theme, a music theme, a famous person-group theme, a sports theme, Brossard discloses an Elvis themed game, but states that "themes based on popular cultural figures or icons, including musical personalities, phono records and/or other types of games (e.g. broadcast game shows)" (col. 1, lines 22-27) are utilized to increase entertainment value.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Thomas and Walker due to their analogous invention types, namely slot machine gaming devices.

**Claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas et al. (US 6,190,255) in view of Walker et al. (US 6,068,552).**

Regarding claim 38, Thomas discloses a gaming device comprising;

a display device,

a primary game operable upon a wager by a player,

a plurality of different game display interfaces operable to be displayed by the display device to represent said primary game to the player, wherein each interface includes a plurality of different symbols, wherein the symbols in each interface perform an identical function in the primary game with respect to corresponding symbols in the other interfaces, and wherein a plurality of the corresponding symbols in the interfaces are visually different from one another, and

an event that causes the display device to switch from displaying on of the interfaces for said primary game to another one of the interfaces for said primary game, as described in the above rejection. While Thomas does disclose the use of a menu operable to be displayed to the player that displays the symbols of the interfaces to the player, Thomas not disclose the use of a player selectable menu operable to be displayed to the player that displays the symbols of the interfaces to the player. Walker discloses a slot machine gaming device that features player selectable parameters, including player selectable paytables (Fig. 3). The disclosed pay tables are essentially menus that display to a player the symbols that may appear in any display interface. A player may select a pay table from the menu by inputting a number of coins (Fig. 3). For instance by inputting 2 coins, the player selects the menu wherein the appearance of a cherry with any pair is awarded 10 credits.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Thomas and Walker due to their analogous inventions, namely slot machine gaming devices.

### *Response to Arguments*

Applicant's arguments with respect to claims 1-51 have been considered but are moot in view of the new ground(s) of rejection.

### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Pertinent prior art includes Nguyen (US 6,857,959), wherein a player may select from a plurality of different display interfaces featuring a plurality of different symbols, said symbols perform identical functions (i.e. provide an award to the player) with respect to corresponding symbols in other interfaces, and wherein a plurality of the symbols are visually different. Specifically, prize symbols are presented to a player in a display interface in accordance with a theme, wherein the player may select the themed interface they wish to choose from.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Meagan Thomasson whose telephone number is (571) 272-2080. The examiner can normally be reached on M-F 830-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571) 272-6788. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Robert E Pezzuto
Supervisory Patent Examiner
Art Unit 3714

Meagan Thomasson
March 9, 2007